UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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SHERR, CRISTINA O

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	**Applicant(s)**
Office Action Summary	09/457,842	SAWADA ET AL.
	Examiner	**Art Unit**	
	Cristina Owen Sherr	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>10 January 2007</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-8,10-16 and 21-25* is/are pending in the application.

　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 3-8, 10-16 and 21-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　a)☐ All　b)☐ Some * c)☐ None of:

　　1.☐ Certified copies of the priority documents have been received.

　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
　Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
　Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This Office Action is in response to applicant's amendment filed January 10,

2007. Claims 1, 3-8, 10-16 and 21-25 are currently pending in this case.

Response to Arguments

2.   Applicant's arguments filed January 10, 2007 have been fully considered but they

are not persuasive.

3.   Applicant argues, with respect to all the pending independent claims, 1, 3, 10 and

13, that nothing in the cited prior art teaches, disclose or suggests charging data for

paying for object data or recognition data for identifying the type of the object data.

4.   Examiner respectfully disagrees and directs attention to Lida, wherein, "Herein, it

could be constituted such that a voice recognition method can be adopted for the entry

of (h) a portion of the melody, and making a recognition of the melody that the customer

is singing using that recognition method, and it could be constituted such that the

recognized melody is further converted to the score corresponding thereto, and then the

converted score is displayed on the screen of the monitor." (col 11 ln 41-48). Thus the

type of object data or melody to be recorded is being recognized. It is obvious and

predictable that the data is being recognized by means of data that is the functional

equivalent of recognition data.

5.   Further, in Lida "By entering the applicable items on the "retrieval screen", i.e., by

entering the attributes of the musical composition, the ISRC thereof is specified. Once

the ISRC is specified, then the "Permission File" and the "Charging Rate & Fee File"

(both of which are described below in more details) are automatically linked in

accordance with the specified ISRC." (col 73 ln 46-51). The "charging rate file is the

functional equivalent of charging data.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 1, 3-8, 10-16 and 21-25 are rejected under 35 U.S.C. 103(a) as being

unpatentable over lida (US 6,209,787).

8.   Lida discloses a data charging system for charging for the use of object data

(e.g. abstract), the system comprising: a server machine for generating contents

containing a plurality of types of object data (e.g. col 2 ln 5-50),

an IC card including a recording medium for recording (i) charging data for paying for

said object data and (ii) recognition data for identifying the type of the object data (e.g.

col 2 ln 40-50),

and a client machines for receiving said contents generated by the server machine (e.g.

col 3 ln40-50),

the client machine' including a data charging apparatus for using said IC card to charge

for the use of said object data by using said charging data and said recognition data

which have been recorded on said IC card (e.g. col 4 ln 20-35);

wherein said data charging apparatus comprises:

data reading logic for reading out said recognition data and said charging data from said recording medium (e.g. col 5 In 30-35);

a separator for separating said object data from said contents (e.g. col 5 In 40-45),

a recognition logic for identifying the specific type of said separated object data by using said recognition data (e.g. col 5 In 45-50);

an accounting logic for dynamically charging for the use of said separated object data, based on the type of data said separated object data is, as determined by using said recognition data, and by using said charging data which has been read out from the recording medium (e.g. col 5 In 60-65),

and a writing logic for writing, as part of said charging data in the recording medium, the results of charging for the use of said separated object data (e.g. col 5 In 55-60).

9.   Although Iida does not use the same terminology or the same order of steps as the instant application, it would be obvious to one of ordinary skill in the art to adapt Iida to obtain the instant application so that copyright owners may be assured their royalties thus providing a return for both the musical industry and musical composers.

10.   Regarding claim 3 –

Iida discloses, in a data charging system including a server machine which records, on an IC Card recording medium, charging data for paying for object data and contained in contents and recognition data used for identifying the type of object data in said contents and pays for the use of said object data by using said charging data and said recognition data which has been recorded in the recording medium, a client machine including a data charging apparatus comprising: a data reading logic for reading said

recognition data and said charging data from said recording medium, a separator for separating said object data from said contents, a recognition logic for identifying the type of said separated object data by using said recognition data read out from the recording medium, an accounting logic for dynamically charging for the use of said separated object, based on the type of data said separated object data is, as determined by using said recognition data, and data by using said charging data which has been read out from the recording medium, and a writing logic for writing, as part of said charging data in the recording medium, the results of charging for the use of said separated object data (e.g. col 5 ln 55-60).

11.   As above, although Iida does not use the same terminology or the same order of steps as the instant application, it would be obvious to one of ordinary skill in the art to adapt Iida to obtain the instant application so that copyright owners may be assured their royalties thus providing a return for both the musical industry and musical composers.

12.   Regarding claim 4 –

LIda discloses the data charging apparatus according to Claim 3, wherein said contents comprise said object data and said recognition data for recognizing this object data, said separator separates said object data and said recognition data from said contents, said recognition logic recognizes said object data, based on said recognition data 'which has been separated from said contents and on said recognition data which has been read out from said recording medium, and said accounting logic charges for said object data by using said charging data which has been read out (e.g. col 4 ln 35-62).

13.   Regarding claim 5 –

Iida discloses a data charging apparatus comprising a watermarking logic for

embedding digital watermarks in said object data which has been separated from said

contents, wherein said separator separates said object data and said recognition data

from said contents, said recognition logic recognizes said object data, based on said

recognition data which has been separated from said contents and on said recognition

data which has been read out from said recording medium, and said accounting logic

charges for said object data embedded with said digital watermarks (e.g. col 6 ln 50-65).

14.   Regarding claim 6 –

Iida discloses a data charging apparatus according to Claim 3, wherein a digital

watermark is embedded in said object data in said contents, said data charging

apparatus further comprising a means for detecting if said object data is embedded with

said digital watermark, said separator separating said object data and said recognition

data from said contents, said recognition logic recognizing said object data, based on

said recognition data which has been separated from said contents and on said

recognition data which has been read out from said recording medium, and

said accounting logic charging for said object data only if said object data is found to be

embedded with said digital watermark (e.g. col 3 ln 50-65).

15.   Regarding claims 7-8 –

Iida discloses a data charging apparatus wherein said charging data recorded on said

recording medium contains at least payment data which indicates payment made in

advance for the use of said object data, and said accounting logic charges for the use of

said object data within limits of an amount indicated by said payment data contained in

said charging data and wherein said charging data recorded on said recording medium

further contains unit price data representing .an accounting unit for the use of said

object data and a price corresponding to the accounting unit, said data charging

apparatus comprising an accounting unit detection logic for detecting unit accounting

amount data which represents an amount of said accounting unit for the object data

which has been separated from said contents, said accounting logic charging within the

limits of the amount indicated by said payment data, based on said unit price data

contained in said charging data which has been read out and on the unit accounting

amount data which has been detected. (e.g. col 55 ln 42-60).

16.   Regarding claim 10 –

lida discloses a data charging method for using a server machine for generating

contents which contain a plurality of types of object data and recognition data used for

the identifying this object data in the generated contents, recording, in an IC card

including a recording medium, (i) charging data for paying for said object data and (ii)

the recognition data used for identifying the specified type of the object data, and

charging for the use of said object data by using said charging data and said recognition

data which have been recorded, comprising the steps of: delivering the generated

contents to a client machine; and using the client machine for reading said recognition

data and said charging data from the said IC card, separating said object data from said

contents, identifying the specified type of said separated object data by using said

recognition data which has been read out from the IC card to charge dynamically for the

use of said separated object data, based on the specified type of data said object data

is, as determined and by using said charging data which has been read out from the

recording medium; and writing as part of said charging data, the results of charging for

the use of said recognized object data (e.g. abstract, col 55 ln 30-65).

17.   As above, although Iida does not use the same terminology or the same order of

steps as the instant application, it would be obvious to one of ordinary skill in the art to

adapt Iida to obtain the instant application so that copyright owners may be assured

their royalties thus providing a return for both the musical industry and musical

composers.

18.   Regarding claims 11-12 –

Iida discloses a data charging method wherein said object data in said contents are

embedded with digital watermarks, comprising the steps of: separating said object data

and said recognition data from said contents; recognizing said object data, based on

said recognition data which has been separated from said contents and on said

recognition data which has been read out from said recording medium; detecting said

digital watermark embedded in said object data; and charging for said recognized object

data only by using said charging data which has been read out if said object data is

found to be embedded with said digital watermark; comprising the steps of: separating

said object data and said recognition data from said contents; recognizing said object

data, based on said recognition data which has been separated from said contents and

on said recognition data which has been read out from said recording medium;

embedding digital watermarks in said separated object data; and charging for the use of

the object data embedded with said digital watermarks by using said charging data

which has been read out (e.g. col 44 ln 42-60).

19.   Regarding claim13 –

Iida discloses in a data charging apparatus of a data charging system which uses a

server machine to record, on an IC card including a recording medium, (i) charging data

used for paying for object data of a specified type and contained in contents and (ii)

recognition data used for identifying the specified type of the object data in said

contents, and charges for the use of said object data by using said charging data and

said recognition data which have been recorded; a computer program product enabling

a client machine that has received said contents to execute the steps of: reading said

recognition data and said charging data, separating said object data from said contents,

identifying the specified type of said separated object data by using said recognition

data which has been read out to charge dynamically for the use of said separated object

data, based on the specific type of data said separated object data is, as determined by

using said, 'recognition data, and by using said charging data which has been read out

from the recording medium, and writing, as part of said charging data, the results of

charging for the use of said recognized object data into said recording medium (e.g.

abstract, col 5 ln 30-65).

20.   As above, although Iida does not use the same terminology or the same order of

steps as the instant application, it would be obvious to one of ordinary skill in the art to

adapt Iida to obtain the instant application so that copyright owners may be assured

their royalties thus providing a return for both the musical industry and musical composers.

21.   Regarding claims 14-16 –

Iida discloses a computer program product wherein said contents contain said object data and said recognition data used for recognition of the object data, said object data and said recognition data are separated from said contents in said separation step, said object data is recognized in said recognition step, based on said recognition data which has been separated from said contents and on said recognition data which has been read out from the recording medium, and a charge is made for said object data in said charging step by using said charging data which has been read out; wherein the computer is made to execute the step of embedding digital watermarks in said object data which has been separated from said contents, said object data and said recognition data are separated from said contents in said separation step, said object data is recognized in said recognition step, based on said recognition data which has been separated from said contents and on said recognition data which has been read out from the recording medium, and a charge is made for said object data embedded with said digital watermarks in said charging step; wherein said object data in said contents are embedded with digital watermarks, the computer is further made to execute the step of detecting that said object data is embedded with said digital watermarks, said object data and said recognition data are separated from said contents in said separation step, said object data is recognized in said recognition step,

based on said recognition data which has been separated from said contents and on

said recognition data which has been read out from the recording medium, and

a charge is made for said object data in said charging step only if said object data is

found to be embedded with said digital watermark (e.g. col 4 ln 6-24).

22.   Regarding claim 21 –

Lida discloses a data charging system according to Claim 1 wherein the server

generates a watermark information about the digital watermark and also embedded in

said contents (e.g. col 8 ln 55-60).

23.   Regarding claims 22-23 –

Iida discloses a method according to Claim 11, further comprising the step of

embedding in said contents information about the digital watermarks; wherein the

embedding step includes the step of embedding in said contents instructions for

embedding the contents with said digital watermarks. (e.g. col 15 ln 55-60).

24.   Regarding claim 24-25 –

Iida discloses a data charging system according to Claim 1, wherein: the content

generator also puts recognition data in said contents; and the object data is identified

based on the recognition data in said contents and said recognition data read from the

IC card; wherein the recognition logic compares the recognition data read out with the

recognition data separated from said contents to determine if said two kinds of

recognition data match (e.g. col 5 ln 30-50).

25. · Examiner's note: Examiner has cited particular columns and line numbers in

the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are

applied to the specific limitations within the individual claim, other passages and figures

may be applied as well. It is respectfully requested from the applicant, in preparing the

responses, to fully consider the references in entirety as potentially teaching all or part

of the claimed invention as well as the context of the passage as taught by the prior art

or disclosed by the examiner.

Conclusion

26.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

27.   Rhoads (US 6,345,104) discloses digital watermarks and methods for security

documents.

28.   Indeck et al (US 5,428,683) disclose a method and apparatus for fingerprinting

and authenticating magnetic media

29.   Leeke et al (US 6,587,127) disclose a content player method and server with

user profile.

30.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

31.   A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

32.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Cristina Owen Sherr whose telephone number is 571-

272-6711. The examiner can normally be reached on 8:30-5:00 Monday through

Friday.

33.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Andrew J. Fischer can be reached on 571-272-6779. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

34.   Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Cristina Owen Sherr
Patent Examiner, Au 3621

ANDREW J. FISCHER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600